UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,710	08/28/2001	Yoichiro Sako	7217/65200	5743

| 530 | 7590 | 11/07/2006 | | |

LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

EXAMINER
ABRISHAMKAR, KAVEH

ART UNIT	PAPER NUMBER
2131	

DATE MAILED: 11/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

		Application No.	Applicant(s)
Office Action Summary		09/940,710	SAKO ET AL.
		Examiner	Art Unit	
		Kaveh Abrishamkar	2131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *18 August 2006*.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *See Continuation Sheet* is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-7, 9-23, 35-37, 39-41, 48-52, 55-57, 59-61, 64-65, 80-81, 84-85, 87-89, 92 and 93* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a) ☒ All   b) ☐ Some * c) ☐ None of:

   1. ☒ Certified copies of the priority documents have been received.

   2. ☐ Certified copies of the priority documents have been received in Application No. _____.

   3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
   Paper No(s)/Mail Date *05/30/2006*.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

Continuation of Disposition of Claims: Claims pending in the application are 1-7,9-23,35-37,39-41,48-52,55-57,59-61,64,65,80,81,84,85,87-89,92 and 93.

DETAILED ACTION

Response to Amendment

1.   This action is in response to the amendment filed on August 18, 2006. Claims 1-
7, 9-23, 35-37, 39-41, 48-52, 55-57, 59-61, 64-65, 80-81, 84-85, 87-89, 92 and 93 are
currently being considered.

Response to Arguments

2.   Applicant's arguments filed August 18, 2006 have been fully considered but they
are not persuasive for the following reasons:

Regarding claims 1, 35, 48, and 80, the Applicant argues that the Cited Prior Art
(CPA), Kuroda et al. (U.S. Patent 6,707,774) in view of Chung et al. (U.S. Patent
6,621,93), does not teach "data read from the recording medium not containing
watermark information. In response to applicant's arguments, the recitation "data read
from the recording medium not containing electronic watermark information" has not
been given patentable weight because the recitation occurs in the preamble. A
preamble is generally not accorded any patentable weight where it merely recites the
purpose of a process or the intended use of a structure, and where the body of the
claim does not depend on the preamble for completeness but, instead, the process
steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190

USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Furthermore, the Applicant argues that the CPA does not teach "preventing said watermark information from being embedded in the decoded data." This argument is not found persuasive. Chung teaches that preventing the watermark information from being embedded when it is going to be played back (column 9 lines 9-36). Chung discloses a digital watermark remover which removes the watermark information if it is embedded in digital video (column 9 lines 34-37), and therefore, prevents the watermark information from being embedded in the playback data. Therefore, it is asserted that the CPA does teach preventing the insertion of the watermark information in decoded data that is selected to be played back.

Finally, the Applicant argues that the CPA does not teach "thereby preventing degradation of the data for playback." In response to applicant's argument that the CPA does not disclose "thereby preventing degradation of the data for playback", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Therefore, the rejection for the pending claims is respectfully maintained as given below.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3.   Claims 1-7, 9-23, 35-37, 39-41, 48-52, 55-57, 59-61, 64-65, 80-81, 84-85, 87-89,

92, and 93 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuroda et

al. (U.S. Patent No. 6,707,774) in view of Chung et al. (U.S. Patent No. 6,621,933).

Regarding claim 1, Kuroda discloses:

A method for outputting data read from a recording medium, said data from the

recording medium not containing electronic watermark information, comprising the steps

of:

decoding the data read from the recording medium (column 2 lines 47-53);

embedding electronic watermark information in the decoded data when the

decoded data is selected as data to be subsequently recorded (column 7 lines 36-45).

Kuroda does not explicitly disclose "preventing said electronic watermark information

from being embedded in the decoded data when the decoded data selected to be

played back, thereby preventing degradation of the data for playback." Chung discloses

preventing the watermark information from being embedded in decode data when it is

going to be output (column 9 lines 9-36, column 12 lines 50-54). Kuroda and Chung are

analogous arts in that both are concerned with decoding video/audio information and

using watermarks for copy protection. Both also have capabilities for removing the watermark (Kuroda: column 8 lines 22-28). It would have been obvious to one of ordinary skill in the art at the time of invention to remove the watermark prior to outputting it for playback, thereby preventing the embedding of a watermark in playback data, to "prevent degradation of image quality" (Chung: column 12 lines 51-52).

Claim 2 is rejected as applied above in rejecting claim 1. Furthermore, Kuroda discloses:

The method according to claim 1, further comprising the steps of determining a type of the recording medium and changing said electronic watermark information based on the type of recording medium (column 7 line 64 – column 8 line 13).

Claim 3 is rejected as applied above in rejecting claim 2. Furthermore, Kuroda discloses:

The method according to claim 2, further comprising the step of embedding electronic watermark information indicating at least a first generation recording is allowed when the recording medium is a read-only recording medium (column 7 lines 5-20).

Claim 4 is rejected as applied above in rejecting claim 3. Furthermore, Kuroda discloses:

The method according to claim 3, further comprising the step of embedding electronic watermark information indicating recording is prohibited when the recording medium is a recordable recording medium (column 7 lines 5 – 20).

Claim 5 is rejected as applied above in rejecting claim 2. Furthermore, Kuroda discloses:

The method according to claim 2, further comprising the step of embedding electronic watermark information indicating the data read from the recording medium when the recording medium is a read-only recording medium (column 19 lines 30-35).

Claim 6 is rejected as applied above in rejecting claim 5. Furthermore, Kuroda discloses:

The method according to claim 5, further comprising the step of embedding electronic watermark information indicating the data is copied data when the recording medium is a recordable recording medium (column 19 lines 30-35).

Claim 7 is rejected as applied above in rejecting claim 2. Furthermore, Kuroda discloses:

The method according to claim 2, wherein the type of recording medium is determined by determining whether a pit wobbling portion is present on the recording medium (column 3 line 58 – column 4 line 3).

Claim 9 is rejected as applied above in rejecting claim 1. Furthermore, Kuroda discloses:

The method according to claim 1, further comprising the step of embedding electronic watermark information for analog data in the decoded data when the decoded data is output in an analog format (column 7 lines 37 – 54).

Claim 10 is rejected as applied above in rejecting claim 9. Furthermore, Kuroda discloses:

The method according to claim 9, wherein the decoded data is converted into an analog signal, and the electronic watermark information for analog data is embedded in the analog signal (column 7 lines 37–54).

Claim 11 is rejected as applied above in rejecting claim 9. Furthermore, Kuroda discloses:

The method according to claim 9, further comprising the step of determining the type of recording medium and changing the electronic watermark information for analog data based on the type of recording medium (column 7 line 64 – column 8 line 13).

Claim 12 is rejected as applied above in rejecting claim 11. Furthermore, Kuroda discloses:

The method according to claim 11, further comprising the step of embedding electronic watermark information including at least first generation recording is allowed when the recording medium is a read-only recording medium (column 7 lines 5-20).

Claim 13 is rejected as applied above in rejecting claim 12. Furthermore, Kuroda discloses:

The method according to claim 12, further comprising the step of embedding electronic watermark information indicating recording is prohibited when the recording medium is a recordable recording medium (column 7 lines 5 – 20).

Claim 14 is rejected as applied above in rejecting claim 11. Furthermore, Kuroda discloses:

The method according to claim 11, further comprising the step of embedding electronic watermark information indicating the data read from the recording medium when the recording medium is a read-only recording medium (column 19 lines 30-35).

Claim 15 is rejected as applied above in rejecting claim 14. Furthermore, Kuroda discloses:

The method according to claim 14, further comprising the step of embedding electronic watermark information indicating the data is copied data when the recording medium is a recordable recording medium (column 19 lines 30-35).

Claim 16 is rejected as applied above in rejecting claim 1. Furthermore, Kuroda discloses:

.The method according to claim 1, further comprising the step of embedding electronic watermark information for digital data when the decoded data is output in a digital format and is selected as the data to be subsequently recorded (column 7 lines 37 – 54).

Claim 17 is rejected as applied above in rejecting claim 16. Furthermore, Kuroda discloses:

The method according to claim 16, further comprising the steps of determining a type of the recording medium and changing the electronic watermark information for digital data based on the type of recording medium (column 7 line 64 – column 8 line 13).

Claim 18 is rejected as applied above in rejecting claim 17. Furthermore, Kuroda discloses:

The method according to claim 17, further comprising the step of embedding electronic watermark information indicating at least first generation recording is allowed when the recording medium is a read-only recording medium (column 7 lines 5-20).

Claim 19 is rejected as applied above in rejecting claim 18. Furthermore, Kuroda discloses:

The method according to claim 18, further comprising the step of embedding electronic watermark information indicating recording is prohibited when the recording medium is a recordable recording medium (column 7 lines 5 – 20).

Claim 20 is rejected as applied above in rejecting claim 17. Furthermore, Kuroda discloses:

The method according to claim 17, further comprising the step of embedding electronic watermark information indicating the data read from the recording medium when the recording medium is a read-only recording medium (column 19 lines 30-35).

Claim 21 is rejected as applied above in rejecting claim 20. Furthermore, Kuroda discloses:

The method according to claim 20, further comprising the step of embedding electronic watermark information including the data is copied data when the recording medium is a recordable recording medium (column 19 lines 30-35).

Claim 22 is rejected as applied above in rejecting claim 1. Furthermore, Kuroda discloses:

The method according to claim 1, further comprising the step of not embedding said electronic watermark information in the decoded data when an operating key is operated to give a playback command to execute a play back operation in an apparatus that has located thereon the recording medium (column 6 lines 13 – 28).

Regarding claim 35, Kuroda discloses:

A method for outputting data read from a recording medium, said data read from the recording medium not containing electronic watermark information, comprising the steps of:

detecting copy management information from the data read from the recording medium (column 7 line 64 – column 8 line 13);

determining the detected copy management information (column 7 line 64 – column 8 line 13); and

embedding electronic watermark information in the data read from the recording medium according to the determined copy management information when the data read from the recording medium is selected as data to be subsequently recorded (column 7 line 64 – column 8 line 13).

Kuroda does not explicitly disclose "preventing said electronic watermark information from being embedded in the decoded data when the decoded data is selected as data to be played back, thereby preventing degradation of the data for playback." Chung discloses preventing the watermark information from being embedded in decode data when it is going to be output (column 9 lines 9-36, column 12 lines 50-54). Kuroda and Chung are analogous arts in that both are concerned with decoding video/audio information and using watermarks for copy protection. Both also have capabilities for removing the watermark (Kuroda: column 8 lines 22-28). It would have been obvious to

one of ordinary skill in the art at the time of invention to remove the watermark prior to

outputting it for playback, thereby preventing the embedding of a watermark in playback

data, to "prevent degradation of image quality" (Chung: column 12 lines 51-52).

4.   Claims 36-37, and 39-41 claim analogous subject matter to the method claims 1-

7, and 9-23 rejected above, and therefore, are rejected following the same reasoning

applied above.

Regarding claim 48, Kuroda discloses:

    An apparatus for playing back a recording medium, comprising:

    a head for reading data from the recording medium, wherein said data read from

the recording medium not containing watermark information (column 7 line 64 – column

8 line 13), wherein the data does not have watermark information before it is added by

the adding unit;

    a decoder for decoding an output signal from said head (column 7 line 64 –

column 8 line 13); and

    an adding unit and a selector unit for embedding electronic watermark

information in the data from said decoder when the data from said decoder is selected

as data to be subsequently recorded (column 7 line 64 – column 8 line 13).

Kuroda does not explicitly disclose "preventing said electronic watermark information

from being embedded in the decoded data when the decoded data is selected as data

to be played back, thereby preventing degradation of the data for playback." Chung

discloses preventing the watermark information from being embedded in decode data

when it is going to be output (column 9 lines 9-36, column 12 lines 50-54). Kuroda and

Chung are analogous arts in that both are concerned with decoding video/audio

information and using watermarks for copy protection. Both also have capabilities for

removing the watermark (Kuroda: column 8 lines 22-28). It would have been obvious to

one of ordinary skill in the art at the time of invention to remove the watermark prior to

outputting it for playback, thereby preventing the embedding of a watermark in playback

data, to "prevent degradation of image quality" (Chung: column 12 lines 51-52).

5.   Claims 49-52, 55-57, 59-61, 64-65 claim analogous subject matter to the method

claims 1-7, and 9-23 rejected above, and therefore, are rejected following the same

reasoning applied above.

Regarding claim 80, Kuroda discloses:

An apparatus for playing back a recording medium, comprising:

a head for reading data from the recording medium, said data read from the

recording medium not containing electronic watermark information(column 7 line 64 –

column 8 line 13), wherein the watermark information is not embedded in the data until

the adding unit adds the watermark;

a detector for detecting copy management information from an output signal from

said head medium (column 7 line 64 – column 8 line 13); and

an adding unit and a selector unit for adding electronic watermark information

according to the detected copy management information to the data read from the

recording medium when the data read from the recording medium is selected as data to

be subsequently recorded (column 7 line 64 – column 8 line 13).

Kuroda does not explicitly disclose "preventing said electronic watermark information

from being embedded in the decoded data when the decoded data is output as

playback data." Chung discloses preventing the watermark information from being

embedded in decode data when it is going to be output (column 9 lines 9-36, column 12

lines 50-54). Kuroda and Chung are analogous arts in that both are concerned with

decoding video/audio information and using watermarks for copy protection. Both also·

have capabilities for removing the watermark (Kuroda: column 8 lines 22-28). It would

have been obvious to one of ordinary skill in the art at the time of invention to remove

the watermark prior to outputting it for playback, thereby preventing the embedding of a

watermark in playback data, to "prevent degradation of image quality" (Chung: column

12 lines 51-52).

6.   Claims 81, 84-85, 87-89, and 92-93 claim analogous subject matter to the

method claims 1-7, and 9-23 rejected above, and therefore, are rejected following the

same reasoning applied above.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

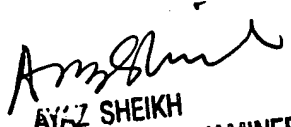than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Kaveh Abrishamkar whose telephone number is 571-

272-3786. The examiner can normally be reached on Monday thru Friday 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Ayaz Sheikh can be reached on 571-272-3795. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KA
11/03/2006

AYAZ SHEIKH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100